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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/303,040 04/30/99 WINSLOW

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EXAMINER

HM12/0619

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PARK, H

ART UNIT

PAPER NUMBER

1645

DATE MAILED:

06/19/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/303,040

Applicant(s)
WINSLOW ET AL.

Examiner
HANKYEL T. PARK, PH.D.

Group Art Unit
1645



☒ Responsive to communication(s) filed on Apr 30, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 37-73 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 37-73 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1645

DETAILED ACTION

1. The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1645.
2. Applicants' submission of the "Preliminary Amendment" is acknowledged. Claims 1-36 are canceled. New Claims 37-73 are pending in the instant application.

Election/Restriction

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 37-57 and 69-72, drawn to a recombinant virus, classified in class 424, subclasses 199.1, 207.1 and 234.1.
 - II. Claims 58-60, 73 and 74, drawn to a vaccine, classified in class 424, subclasses 199.1, 204.1, 207.1, 224.1 and 229.1 and in class 536, subclasses 23.72 and 24.2.
 - III. Claims 61 and 64, drawn to a method for enhancing an immune response, classified in class 435, subclass 5, 69.1, 69.7 and 172.3.
 - IV. Claim 62, drawn to a method for immunizing, classified in class 435, subclass 5, 69.1, 69.7 and 172.3.
 - V. Claims 63 and 65, drawn to a method for suppressing an immune response comprising administering recombinant virus, classified in class 435, subclass 5, 69.1, 69.7 and 172.3.

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VI. Claim 66, drawn to a method for suppressing an immune response administering an antisense nucleic acid, classified in class 435, subclass 5, 69.1, 69.7 and 172.3 .

VII. Claims 67 and 68, drawn to a method for reducing or abrogating a tumor, classified in class 435, subclass 7.23.

4. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions. The invention of I is a recombinant virus comprising at least one foreign gene which can be used to isolate a protein encoded by the foreign gene, whereas the invention of II is a vaccine used to induce an immune response in a host.

5. Invention I and Inventions III-V and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product of Invention I can be used for enhancing an immune response (Invention III) or for immunizing (Invention IV) or for suppressing an immune response (Invention V) or for reducing or abrogating a tumor (Invention VI) .

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6. Inventions III-VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different effects, such as for enhancing an immune response, for suppressing an immune response or for reducing or abrogating a tumor.

7. Invention II and Inventions III-VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation. The invention of II is a vaccine composition and the Inventions III-VII are methods using a different product, i.e. a recombinant virus.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

9. This application contains claims directed to the following patentably distinct species of the claimed invention: **1A-raccoonpox virus; 1B-swinepox virus; 1C-feline herpesvirus.**

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, the recombinant virus of Claim 41 is generic.



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10. This application contains claims directed **also** to the following patentably distinct species of the claimed invention: **2A-a feline pathogen; 2B-a rabies virus; 2C-Chlamydia; 2D-Toxoplasmosis gondii; 2E-Dirofilaria immitis; 2F-a flea; and 2G-a bacteria pathogen.**

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, the recombinant virus of Claim 45 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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11. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

12. Papers relating to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 located in Crystal Mall 1. The Fax number for Art Unit 1645 is (703) 308-4426. All Group 1600 Fax machines will be available to receive transmissions 24 hrs/day, 7 days/wk. Please note that the faxing of such papers must conform with the Notice published in the Official Gazette, 1096 OG 30, (November 15, 1989).

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Hankyel T. Park, Ph.D., whose telephone number is (703) 305-7255.

The Examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 6:30 AM-4:00 PM, (EST). The Examiner can also be reached on alternate Wednesdays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's acting supervisor, Anthony Caputa, can be reached at (703) 308-3995.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Hankyel T. Park, Ph.D.
Primary Examiner
June 17, 2000



HANKYEL PARK
PATENT EXAMINER